

REMARKS

The foregoing amendment does not include the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the above amendment be entered in and that the claims to the present application be, kindly, reconsidered.

The Office Action dated May 6, 2004 has been received and considered by the Applicants. Claims 1-4 are pending in the present application for invention. Claims 1-4 are rejected by the May 6, 2004 Office Action.

The Office Action rejects Claims 1-4 under the provisions of 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,341,353, issued to Yoshio, et al. (hereinafter referred to as Yoshio et al.). The Examiner rejecting Claim 1, states that Figs. 4-13 of Yoshio et al. show a device for recording and/or reproducing an optical record carrier comprising all features of the claimed invention as interpreted. The Examiner's position is that Figs. 4-13 of Yoshio et al. anticipate the invention as defined by rejected Claim 1. The Applicants, respectfully disagree.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The Examiner states that Yoshio et al. disclose the selection signal is derived from the output signal of the selection element. The Applicants would like to, respectfully, point out that Figs. 4-13 of Yoshio et al. show a device having a switch 11 that the Examiner reads on the recitation for "a selection element for selecting one of the position signals as an output signal in response to a selection signal". The Applicants, respectfully point out that the next element within rejected Claim 1 wherein "the selection signal is derived from the output signal of the selection element" is not disclosed, suggested by Figs. 4-13 of Yoshio et al. or the description related, thereto. The Examiner makes the assertion that the selection signal is derived from the output signal of the selection element is taught by Figs. 4-13 of Yoshio et al., however, the Office Action does not indicated the elements within Yoshio et al. perform this feedback selection feature as recited by rejected Claim 1. The Applicants, respectfully, draw the Examiner's attention to Figs. 4-13 of Yoshio et al., and the description related thereto. The output of switch 11 is not used to control switch 11 to determine the position of switch 11. Therefore, the Applicants respectfully assert that "the selection signal is derived from the output

signal of the selection element” is not disclosed, suggested by Figs. 4-13 of Yoshio et al.

Additionally, ejected Claim 1 recites three primary position signals and switch 11 only selects between two signals. Therefore, there are additional elements not found in the rejection made by the Office Action. Therefore, the disclosure of cited prior art reference Yoshio et al. do not teach every element of the claimed invention.

The Applicants, respectfully, assert that rejection of Claims 1-4 are not inherently anticipated by Yoshio et al. To anticipate under the principles of inherency, the prior art must function in accordance with the claimed limitations in order to anticipate. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The teachings of Yoshio et al. relate to an analog device (e.g. there is no analog to digital conversion that takes place) whereas the present invention functions in the digital domain. The Examiner has not shown any analog feedback derived from the output of switch signal that is used to control the position of the switch. Therefore, Yoshio et al. do not teach a system that functions in accordance with the claimed limitations of the present invention as recited by rejected Claim 1. Therefore, this rejection is respectfully traversed.

The Examiner making the rejection with regard to Claim 2, states that Figs. 4-13 show a device for recording and/or reproducing an optical record carrier wherein at least one secondary position signal is obtained by adding a constant value to a primary position signal. The Applicants respectfully disagree with this assertion contained in the Office Action. Yoshio et al. do not teach wherein any of the secondary position signals are obtained by adding a constant value to a primary position signal. In fact Yoshio et al. teach implementing subtractors 5, 6, and 7 and there is no teaching, or suggestion, for subtracting a constant value. Therefore, this rejection is respectfully traversed.

Regarding the rejection to Claim 3, as previously stated Yoshio et al. teach an analog device and a look up table is well known in the art as being a digital memory device. There is no look up table in Yoshio et al. There is not any mention of memory devices that could function as a look up table within Yoshio et al. Furthermore, there is no teaching of deriving the signal that is used to control switch 11 within Yoshio et al. Therefore, this rejection is traversed.

The Examiner in making the rejection to Claim 4 states that Figs. 4-13 show a device for recording and/or reproducing an optical record carrier characterized by a

computation means for deriving the selection signal from the output. The Applicants point out that there are no computational means taught within Yoshio et al. The Applicant request that the Examiner indicated the computational means that the Examiner asserts is found with Yoshio et al. The Applicants assert that there is no device within Yoshio et al. that can reasonably be construed as being equivalent to computational means for determined the output of switch 11. Therefore, this rejection is respectfully traversed.

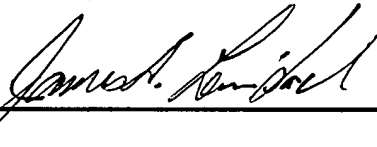
The foregoing amendment has added new claims 5-20 that define the invention as described in the detailed description within the specification. New claims 5-20 define the invention in a scope similar to Claims 1-4 and are believed allowable over the cited references for that reason. New claims 5-20 additionally define subject found within the specification on pages 2-7 that is not disclosed, or suggested by the cited references. Therefore, new Claims 5-20 do not attempt to introduce new matter into the present application for invention. Accordingly, these new Claims 5-20 are believed to be allowable.

In an effort to move the present application for invention towards allowance, the Applicants have amended the claims to the invention.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By 

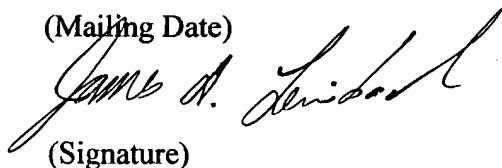
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited this date with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop: Amendment, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450

on: August 6, 2004

(Mailing Date)



(Signature)